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April 6, 2000

Reference: 7755/0D276

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VIA FACSIMILE - 011 44 113 243 0446 - 17 Pages

RECEIVED

JUL 25 2000

OFFICE OF PETITIONS

Mr. Robin F. Browne
Urquhart-Dykes & Lord
Tower House - Merrion Way
Leeds LS2 8PA, ENGLAND

Re: U.S. Patent Application Serial No. 08/999,752
Fiona Catherine MILLAR (NORTON HEALTHCARE LIMITED)
Your Reference RFB/SL/P98765US

Dear Robin:

Not having heard from the Examiner since I saw him in February, I called him to ascertain the status of this matter.

Apparently the delay was caused by much activity surrounding the subject matter of this application, which I shall describe to the best of my ability hereafter.

Examiner Page assured me that within the next week he will follow up on his earlier promise to withdraw the Final Rejection and cite additional art. He told me that this additional art would be Bargigia et al. U.S. Patent 4,174,295 (a copy of which is enclosed for your review).

It is not immediately clear to me exactly how the Examiner would propose applying this patent. It is primarily directed to hair sprays, but clearly exemplifies formulations of fluorocarbon propellants with solvents such as ethanol, not containing a surfactant. You will note that Example 1 shows the use of Freon 22 and Freon 142b composition admixed with a hair lacquer which contains anhydrous ethanol. This formulation does not appear to have any surface-active agent in it.

As to surrounding activity, Exr. Page advised me that one of the reasons for his delay in responding was that he was contemplating placing this application in interference, an interference which already has some fourteen patents and patent applications involved. All of these apparently relate to aerosol compositions which are substantially free of surfactant; e.g., U.S. Patent 5,653,962 of Akehurst et al. to Glaxo (copy enclosed) is apparently an example of one of these patents. You will note that this reference calls for a formulation free of surfactant or having less than 0.0001% of

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surfactant. I do not know exactly how much surfactant is used in the conventional systems but, if (as proposed) we limit the claims in this application to "free of surfactants" to get the case allowed, by virtue of the doctrine of file wrapper estoppel, we would have difficulty asserting that the claim covered a composition which has 0.0001% or more of surfactant. While I cannot be sure (because of my lack of understanding of industrial practice), I would think that such a claim would be substantially useless to Norton Healthcare.

Just by way of background, the Examiner indicated that Glaxo filed a series of applications naming individual drugs in aerosol formulations being free of or having less than 0.0001% of surfactant. It was only when they obtained the Akehurst et al. patent, which is not specific to a particular medicament, that the interference arose. Note that this patent's claims are specific to the 1,1,1,2-tetrafluoroethane propellant (P134a).

To conclude, no action on our part is necessary now. I have been assured the Final Rejection will be withdrawn and the Bargigia et al. patent will be cited in what may or may not be another Final Rejection. Less certain is the question of whether we will be invited to join the multi-party interference discussed above. If entering the interference becomes necessary, your client should be made aware that it will entail significant expenses.

I'll be back in touch with you as soon as I receive further word. On the other hand, if you wish to discuss, please call.

My very best regards to you and your family.

Sincerely,



Bert J. Lewen

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Enclosures